

REMARKS

This communication is in response to the office action mailed August 9, 2007.

In the office action, all the claims are rejected as being anticipated by Goto, or obvious over Goto in view of VanDeusen.

Taking the anticipation rejection first, it is noted that, similar to the discussion in the Background portion of Applicant's specification, the Goto device employs an "axial" cable, with the sense pin and force pin connected together as the central conductor of a coaxial cable, and the signal line from the guard pin being connected to the outer conductor of the coaxial cable. See [0030] of Goto which reads (emphasis added)

Forty-eight connectors 130, in four rows of twelve columns, are arranged on one side of the connection box 100. These connectors are triaxial connectors, that is, double coaxial connectors; they are connected to the 48 pin assemblies 107. As shown in FIGS. 1(a) and (b), signal lines from the sense pin 102 and the force pin 104 of teach pin assembly are connected together at the outlet of the pin assemblies 107 and they are connected to the central conductor or central contact 108 in the triaxial connector 130, through the core of the coaxial cable 114. The signal line from the guard pin 106 is connected to the outer conductor of the coaxial cable 114 at the outlet of the pin assemblies 107, and this is connected to the middle conductor or inner shell 110 of the triaxial connector 130 through the coaxial cable 114. The outer conductor or outer shell 112 of the triaxial connector 130 is connected to the grounded chassis of the connection box 100. Furthermore, the triaxial connectors used may be previously known technology, such as that described in Japan Patent Publication No. Hei 6[1994]-249,913.

Goto does not disclose a cable including a plurality of wires with at least one wire for sensing a signal from a DUT, at least one wire for a forcing signal to the DUT, and at least one wire for a guarding signal driven the same electrical signal as the forcing signal, wherein the at least one wire for sensing a signal, the at least one wire for a forcing signal, and the at least one wire for a guarding signal are each separately connectable to the electronic test equipment.

Furthermore, to the extent the Goto "outer conductor of the coaxial cable 114," to which the guard pin is connected (see [0030] of Goto), is considered by the Examiner to disclose the "outer metal coating surrounding the plurality of wires," then Goto does not disclose at least one of a "plurality of wires" for a guarding signal, where the outer metal coating surrounds the plurality of wires. That is, outer conductor of coaxial cable 114 cannot be both elements of the claim – i.e., at least one of a plurality of wires for a guarding signal and the outer metal coating surrounding the plurality of wires.

The Examiner's alternate rejection with respect to claim 1 involves VanDuesen, the Examiner contending "VanDeusen discloses electrical cable and explicitly discloses metal

coating (5) and insulating coating around metal coating (5) (Figure 1).” The Examiner further contends:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the metal coating and insulating as taught by VanDeusen into the system of Goto et al. because the metal coating and the insulating is the principle of the cable.

Applicant does not dispute that cables having an outer metal coating and insulating coating around the outer metal coating are known. In fact, Applicant’s own specification discloses the use of a known “mini-USB” cable. However, the combination of Goto and VanDeusen would not yield the presently-recited subject matter. More particularly, since Goto fails to disclose the plurality of wires as recited in claim 1 as discussed above, the combination as posited by the Examiner would at best yield a coaxial or triaxial cable surrounded by an outer metal coating and an insulating coating around the other metal coating.

Furthermore, even in the recently-decided KSR case, the Court reaffirmed that obviousness in 35 USC 103 should be determined under principles of Graham and other Supreme Court precedents on obviousness. The Court stated that while the teaching, suggestion, motivation (TSM) test applied by the Court of Appeals for the Federal Circuit is not necessarily inconsistent with the Graham analysis, that test should not be rigidly applied to limit the obviousness inquiry. The Court also stated:

“Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).”

Therefore, while the TSM test should not be rigidly applied, to find obviousness there must still be articulated reasoning with some rational underpinning to support a conclusion of obviousness. Obviousness cannot be sustained by mere conclusory statements. The Examiner’s conclusory statements regarding “the principle of the cable” does not provide a rational underpinning to support a conclusion of obviousness to modify Goto in view of VanDeusen.

Claims 2-5 are rejected as being obvious over Goto in view of Fang, the Examiner contending that “Goto et al. discloses every subject matter recited in the claim except [sic] for the receptacle connector includes a metal housing.” Applicant has amply demonstrated above that

Goto does not, in fact, disclose all the subject matter of claim 1 (upon which claim 2-5 depend). Nor does Fang make up for the deficiencies in Goto. Therefore, the rejection of claims 2-5 should be withdrawn.

CONCLUSION

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
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